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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/076,370

02/19/2002

Marc Alizon

2356-0011-10

2811

22852

7590

03/22/2006

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EXAMINER

PARKIN, JEFFREY S

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/076,370

Applicant(s)

ALIZON ET AL.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-28 and 31-50 is/are pending in the application.
- 4a) Of the above claim(s) 40-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-28 and 31-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Serial No.: 10/076,370  
Applicants: Alizon, M., et al.

Docket No.: 2356.0011-10  
Filing Date: 02/19/02

### **Detailed Office Action**

#### **37 C.F.R. § 1.114**

A request for continued examination under 37 C.F.R. § 1.114, including the fee set forth in 37 C.F.R. § 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. § 1.114, and the fee set forth in 37 C.F.R. § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. § 1.114. Applicants' submission filed on 21 October, 2005, has been entered.

#### **Status of the Claims**

Claims 23-28 and 31-50 are pending in the instant application. Claims 40-50 stand withdrawn from further consideration as being directed towards a nonelected invention (refer to 37 C.F.R. § 1.142(b) and M.P.E.P. § 821.03). Claims 23-28 and 31-39 are currently under examination. Applicants traversal of the restriction requirement is noted but is not convincing. First, contrary to applicants' assertion, the claims are directed toward a different set of Env polypeptides. The originally presented claims were directed toward Env variants having one or more amino acid substitutions at defined locations. The newly presented claims are directed toward specific Env polypeptides (e.g., aa 680-700) and are not coextensive in scope and nature. Moreover, the methodology claims encompass both detection assays and immunization assays employing an HIV vaccine. These will generate unique issues concerning patentability and require separate searches. Accordingly, the withdrawal of claims 40-50 from further consideration was appropriate.

**35 U.S.C. § 112, First Paragraph**

The following is a quotation of the first paragraph of 35 U.S.C.

§ 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23-28 and 31-39 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 43 U.S.P.Q.2d 1398, (Fed. Cir. 1997). *Fiers v. Revel Co.*, 984 F.2d 1164, 25 U.S.P.Q.2d 1601, (Fed. Cir. 1993). *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 18 U.S.P.Q.2d 1016, (Fed. Cir. 1991). *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 296 F.3d 1316, 63 U.S.P.Q.2d 1609, (Fed. Cir. 2002). *Univ. of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 920, 69 U.S.P.Q.2d 1886, (Fed. Cir. 2004). *In re Rasmussen*, 650 F.2d 1212, 211 U.S.P.Q. 323 (C.C.P.A. 1981). *In re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90 (C.C.P.A. 1976). *University of Rochester v. G. D. Searle & Co., Inc.*, 358 F.3d 916, 69 U.S.P.Q.2d 1886 (C.A.F.C. 2004). Claims 23-26 and 31 are directed toward immunogenic HIV-1 Env polypeptides of 5-150 aa comprising at least one amino acid substitution at a specified position (e.g., aa 8, 9, 90, 102, 131, 133, 140, 156, 172, 177, 179, 185, 188, etc.). Thus, the claims encompass single or multiple amino acid substitutions at over 54 different locations. Claims 27, 28, 32, and 33 are directed toward methodologies that require these peptides. Claims

34-39 are also directed toward immunogenic HIV-1 Env polypeptides comprising one of the aforementioned substitutions and include additional limitations pertaining to the overall peptide length (e.g., 21 aa, 43 aa, 79 aa, etc.).

As previously set forth, in order to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had **possession** of the claimed invention. See, e.g., *Vas-Cath, Inc., v. Mahurkar*, 935 F.2d at 1563, 19 U.S.P.Q.2d at 1116. The issue raised in this application is whether the original application provides adequate support for the broadly claimed genus of **immunogenic polypeptide fragments** comprising **HIV-1<sub>MAL</sub> epitopes** of **5-150 amino acid residues** wherein **at least one amino acid residue is substituted at one of the specified positions**. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that **fully set forth the claimed invention**. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997). The claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. **A biomolecule sequence (e.g., epitope) described only by functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the biomolecule of interest.** *In re Bell*, 991 F.2d 781, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993). *In*

re *Deuel*, 51 F.3d 1552, 34 U.S.P.Q.2d 1210 (Fed. Cir. 1995). A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 U.S.P.Q.2d 1895, 1905 (Fed. Cir. 1995). The court noted in this decision that a laundry list disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not reasonably lead those skilled in the art to any particular species.

An applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. An applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. For some biomolecules, examples of identifying characteristics include a nucleotide or amino acid sequence, chemical structure, binding affinity, binding specificity, and molecular weight. The written description requirement may be satisfied through disclosure of function and minimal structure when there is a well-established correlation between structure and function. Without such a correlation, the capability to recognize or understand the structure from the mere recitation of function and minimal structure is highly unlikely. In the latter case, disclosure of function alone is little more than a wish for possession; it does not satisfy the written

**description requirement.** *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 U.S.P.Q.2d 1398, 1404, 1406 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998). *In re Wilder*, 736 F.2d 1516, 1521, 222 U.S.P.Q. 369, 372-3 (Fed. Cir. 1984). Factors to be considered in determining whether there is sufficient evidence of possession include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention.

As previously noted, perusal of the disclosure reveals the cloning and characterization of a novel human immunodeficiency virus type 1 originally designated lymphadenopathy associated virus (LAV) MAL, or LAV<sub>MAL</sub>. A proviral molecular clone was obtained and complete nucleotide isolate of this sequence ascertained (see Figs. 7A-7I). The deduced amino acid sequences of the various viral structural and non-structural genes were also set forth in Figure 7. Specific envelope polypeptide fragments were set forth on p. 36 of the specification (e.g., 1-530, 34-530, 531-877, 680-700, 37-130, 211-289, 488-530, and 490-620). It should be noted that these designations actually referenced LAV<sub>BRU</sub> amino acid sequences, not specific LAV<sub>MAL</sub> polypeptides. Thus, the skilled artisan might conclude that applicants contemplated making and using these specific envelope polypeptides. However, the skilled artisan would not reasonably conclude that applicants were in possession of the claimed invention.

First, the disclosure fails to identify specific HIV-1<sub>MAL</sub> immunogenic fragments of the claimed lengths and substitutions. The specification only sets forth the deduced amino acid sequences of the full-length non-structural and structural genes as set forth in Figure 7 and the specific Env fragments set forth on p. 36. Figure 3 also fails to identify immunogenic MAL peptides. This

figure simply provides an amino acid comparison between MAL, BRU, ARV-2, and ELI to assess their genetic relatedness. The figure does not identify or lead the skilled artisan to any particular immunogenic fragment, particularly one carrying amino acid substitutions. Second, the disclosure fails to perform any type of comparison wherein specific immunogenic fragments from isolate MAL are identified and acceptable amino acid substitutions are performed. It is well-known in the art that subtle perturbations in an amino acid sequence can profoundly affect both the immunogenic and antigenic properties of any given polypeptide. Thus, the skilled artisan can only hazard a guess as to which substituted MAL fragments will remain immunogenic. Third, the disclosure fails to provide adequate support for MAL-specific polypeptides the recited lengths (e.g., 21, 43, 79, 94, and 131 aa). The only numerical limitations set forth in the disclosure recite immunogenic polypeptides or fusion proteins which may contain between 5 and 150 amino acids (see p. 28). Thus, support does not exist for the current size limitations. Nothing in the disclosure directs the skilled artisan toward any particular MAL immunogenic fragment or any fragment carrying amino acid substitutions. The disclosure fails to identify those molecular determinants modulating the immunogenicity of any given polypeptide fragment. Clearly, the claimed invention simply represents an attempt by applicants to capture subject matter which was neither described nor contemplated at the time of filing. Accordingly, the skilled artisan would reasonably conclude that applicants were not in possession of the claimed invention at the time of filing.

#### **Response to Arguments**

Applicants provide a declaration by Dr. Marie-Lise Gougeon in support of their position. Dr. Gougeon asserts that upon carefully reading the specification the skilled artisan would be able to



identify conserved and non-conserved amino acids and identify suitable immunogenic polypeptide candidates. Dr. Gougeon's declaration appears to misunderstand the crux of the rejection. The crux of the rejection is not whether or not the skilled artisan would be capable of making the claimed peptides, but whether or not the inventors were in **possession** of the claimed invention at the time of filing. As previously set forth, the disclosure provided a comparison between MAL, BRU, ARV-2, and ELI to assess their genetic relatedness. The figure does not identify or lead the skilled artisan to any particular immunogenic fragment, particularly one carrying any one of a number of amino acid substitutions. The skilled artisan upon perusal of the disclosure would reasonably conclude that applicants were in possession of the HIV-1 Env polypeptides set forth in page 36 of the specification. Specifically, applicants clearly contemplated making and using polypeptides corresponding to regions 1-530, 34-530, 531-877, 680-700, 37-130, 211-289, 488-530, and 490-620. However, nothing in the disclosure sets forth any additional Env polypeptide fragments. The disclosure is also silent concerning the generation of polypeptide variants having amino acid substitutions at the recited positions (e.g., 8, 9, 90, 102, 131, etc.). The references cited by Dr. Gougeon also fail to remedy the defects in the specification.

Applicants additionally provide a number of documents suggesting that one skilled in the art would easily be able to prepare the claimed polypeptides (Holmback et al., 1993; Burton et al., 2004; Frahm et al., 2004; Yang et al., 2004; Lacal et al., 1986). Once again these references do not address the crux of the rejection which is whether or not the inventors were in **possession** of the claimed invention. The issue is not whether or not the skilled artisan can make the claimed polypeptides but whether or not applicants were in possession of the claimed polypeptides. There

is nothing in the disclosure that leads the skilled artisan to any particular polypeptide variant. Accordingly, the rejection is proper and hereby maintained.

### **Correspondence**

Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (571) 272-0908. The examiner can normally be reached Monday through Thursday from 10:30 AM to 9:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, James C. Housel, can be reached at (571) 272-0902. Direct general status inquiries to the Technology Center 1600 receptionist at (571) 272-1600. Informal communications may be submitted to the Examiner's RightFAX account at (571) 273-0908.

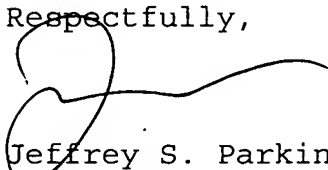
Applicants are reminded that the United States Patent and Trademark Office (Office) requires most patent related correspondence to be: a) faxed to the Central FAX number (571-273-8300) (updated as of July 15, 2005), b) hand carried or delivered to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314); c) mailed to the mailing address set forth in 37 C.F.R. § 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or d) transmitted to the Office using the Office's Electronic Filing System. This notice replaces all prior Office notices specifying a specific fax number or hand carry address for certain patent related correspondence. For further information refer to the Updated Notice of Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence, and Exceptions Thereto, 1292 Off. Gaz. Pat. Office 186 (March 29, 2005).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access

Serial No.: 10/076,370  
Applicants: Alizon, M., et al.

to the Private PAIR system, contact the Electronic Business Center  
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Respectfully,



Jeffrey S. Parkin, Ph.D.  
Primary Examiner  
Art Unit 1648

19 March, 2006